

## **REMARKS**

### **Status of the Claims**

Upon entry of the amendment above, claims 8-26 will be pending, claims 8, 13, and 21 being independent.

### **Summary of Office Action**

Claims 8-14 and 16 are rejected under 35 USC §102(b) as being anticipated by WO 02/49728 ("WO '728).

Claims 15-24 are rejected under 35 USC §103(a) as being unpatentable over WO '728 in view of HAUGHLIN (U.S. Patent No. 5,664,797).

### **Response to the Office Action**

#### **A. Summary of the Amendment**

Amendments of a cosmetic nature have been made to five paragraphs of the specification.

Independent claim 8, directed to a "cross-country ski system," has been amended for clarification as to the structure and arrangement of the upper support surface of the ski (e.g., "being exposed laterally of the binding zone" of the ski).

Independent claim 13, directed to a cross-country system that comprises at least a cross-country ski and a binding device for a boot, has been amended by being placed in independent form. In so doing, Applicants have further specified that the binding device includes a mechanism for engagement with the boot. This latter limitation is in response to the rejection of this claim by which a mere plate upon which a binding is mounted (i.e., in WO '728) is characterized as a "binding device."

Dependent claims 15, 18, and 22 have been amended to specify that it is the entire cross-country ski system that includes no baseplate mounted on the ski for direct support of the boot so that the boot is supported directly by the upper surface of the ski.

Dependent claim 16 has been amended to improve its presentation.

Dependent claim 17 has been amended for consistency with an aforementioned amendment to parent claim 16.

Independent claim 21 has been amended for clarification of the relative positions of the support surfaces of the ski for the boot, the binding, and the longitudinal recess for receiving the binding.

New dependent claims 25 and 26 have been added.

**B. Withdrawal of the Rejection of Claims 15-24 Based Upon WO '728 + HAUGHLIN**

Applicants kindly request reconsideration and withdrawal of the rejection of claims 15-24 under 35 USC §103(a) as being unpatentable over WO '728 in view of HAUGHLIN at least for the following reasons.

While the analysis of a claim, in the context of 35 USC §103, allows flexibility in determining whether a claimed invention would have been obvious, as expressed in *KSR Int'l Col. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007), it still requires that "there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." *Id.* "We must still be careful not to allow hindsight reconstruction of references to reach the claimed invention without any explanation as to how or why the references would be combined to produce the claimed invention." *Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1374 n.3 (Fed. Cir. 2008).

Applicants respectfully submit that one skilled in the art would not have installed a cross-country binding like that of HAUGHLIN on the positioning-attachment assembly of WO '728, as set forth in the rejection.

The rejection is premised upon the assertion that elements 42' and 42" of WO '728 are binding devices. See, e.g., page 4, lines 1-2. Moreover, on page 5, lines 1-2, the assertion is made that "WO ['728] discloses the binding device is adapted to be fitted within the recess of the upper surface of the ski (WO ['728], fig 6) ...."

Applicants disagree.

The plates (i.e., the "sliders," as characterized by WO '728) 42, 42', 42" are mounted in the recess, i.e., within the guides 41, 41', 41", but there is no binding device fitted within such recess.

In fact, the first sentence of the text of WO '728 explains that:

The present invention relates to a ski or similar skating requisite with incorporated assembly for adjustable attaching a ski binding, namely such assembly, which is in common capable to serve as a positioning part and also as an attaching part of a ski binding or also e.g. of a snowboard binding, and which is incorporated into a ski or similar skating requisite already during the process of manufacturing thereof.

That is, WO '728 discloses a positioning-attachment assembly. See, e.g., the paragraph bridging pages 4 and 5. On page 5, lines 8-11, WO '728 characterizes its invention as being a positioning-attachment assembly that is part of the ski (i.e., built into the ski) and that it can be regarded as forming a part of a ski binding. However, a binding device is not, as such disclosed.

The illustrated and described embodiments of WO '728 are directed to *alpine skis*. Such skis, as explained by WO '728 on page 2, lines 10-11, are fitted with "modern ski bindings" which consist of a forward part and a rearward part, i.e., a front binding and a rear binding (also commonly referred to as a toe binding and a heel binding).

The paragraph bridging pages 11 and 12 of WO '728 explains that the front binding is to be mounted upon the forward slider (42, 42') and the rear binding is to be mounted upon the rear slider (42, 42') and that the relative positions of the bindings can be adjustably positioned and fixed in place.

As seen in Figs. 5, 6, and 7 of WO '728, the upper surfaces of the sliders 42, 42', 42" project upwardly beyond the upper ski surface, so that the sliding of the associated binding, when fixed to its respective slider, is not obstructed by the upper surface of the ski.

Further, page 9, lines 3-10 of WO '728 explains that the binding mounting area 3 has a height that "is somewhat higher as it would be necessary in common."

Thus, the bindings are mounted on a mounting area that is elevated higher than normal and that the positioning-attachment assembly of WO '728 includes mounting plates (i.e., "sliders") that project higher yet.

This feature of WO '728 is quite contrary to Applicants' invention. See, e.g., Applicants' paragraph 0007.

The foregoing notwithstanding, Applicants submit that none of WO '728, HAUGHLIN, or the combination of the two, teach or suggest Applicants' invention as set forth in the rejected claims.

First, Applicants submit that one skilled in the art would not have been taught how to adapt WO '728 for use with a cross-country binding like that of HAUGHLIN and, for this reason, withdrawal of all of the rejected claims is kindly requested. Each of the embodiments of WO '728 includes a pair of longitudinally spaced-apart sliders (42, 42', 42'') which pair mount a toe binding and a spaced-apart heel binding. The cross-country binding of HAUGHLIN is a single integrated binding; there are no separate front and rear pieces. If HAUGHLIN's binding were to be positioned on the WO '728 positioning-attachment assembly, a significant longitudinally central part of the binding would be unsupported.

Second, even if the HAUGHLIN binding were to be mounted on the WO '728 positioning-attachment assembly, HAUGHLIN includes a baseplate that would prevent direct engagement between the upper support surface(s) of the ski and the boot, as specified in Applicants' claims 15, 18, and 22.

In this regard, Applicants submit that the statement on page 11, lines 15-17 of the Office action is erroneous, that is, "[a]s modified the boot of the wearer would necessarily contact the top surface of the ski when pressure is applied since only a portion of the binding contacts the boot and the remainder of the boot is supported by the ski." That is, with reference, e.g., to Applicants' claim 21, lines 12-14, there would be no exposed upper support surfaces for direct contact with the sole of the boot on opposite lateral sides of the binding device.

Third, in supporting the rejection, the Office action explains (page 5, lines 5-7) that "WO '728 is silent as to the specifics of the binding device ...." Yet, it is explained that "... it is known to substitute ski bindings and ski boots to a more safe binding (pg 3, ln 22-24, pg 4, ln 5, pg 7 2<sup>nd</sup> full paragraph)."

The mention of a “safety ski binding” in the text of WO ‘728 are references to what is commonly understood to those skilled in the art as bindings for alpine skis as explained, e.g., on page 4 of the document of the International Ski Federation entitled “Specifications for Competition Equipment (see <http://www.fis-ski.org/forms/FisRulesDocs/RulesEquipment.pdf>). That is, reference to “safety ski bindings” in WO ‘728 is, in fact, a teaching away of the combination of WO ‘728 and HAUGHLIN.

**C. Withdrawal of the Rejection of Claims 8-14 and 16 Based Upon WO ‘728**

Applicants kindly request reconsideration and withdrawal of the rejection of claims 8-14 and 16 under 35 USC §102(b) over WO ‘728 at least for the following reasons.

As mentioned above, WO ‘728 is directed to a particular structure for an *alpine* ski (see, e.g., the second paragraph of page 1 of the text of WO ‘728, as well as the second paragraph of page 8) and includes structures which are incompatible with the terms of Applicants’ claims. In this regard, “when a skier using the cross-country ski system exerts a pressure force with the boot toward the ski” (as Applicants specify in claim 8) “the upper support surface [is] exposed laterally of the binding zone [of the ski] for coming in direct contact with the boot.”

Applicants respectfully submit that WO ‘728 is non-responsive to this language of claim 8.

If conventional front and rear alpine bindings, i.e., such as the aforementioned *safety* bindings, were to be mounted on the ski of WO ‘728 (such bindings not being illustrated in the drawings of WO ‘728), the boot would directly contact the support plates of the bindings – i.e., the boot would not directly contact the ski.

Indeed, if the boot were to contact the upper surface of the ski, such contact would impede the function of a lateral release of a toe binding, for example.

Nevertheless, page 3 of the Office action, in lines 3-5, includes the assertion (with regard to WO ‘728) “the upper support surface being capable of coming in direct contact with the boot when a skier using the cross-country ski system exerts a pressure force (fig 6, element 5’ and

5")." Further, page 2, last line, to page 3, line 1 of the Office action includes the assertion that the upper support surface of the ski of WO '728 is "arranged on at least one of two lateral sides (elevated central area 3 in figs 5-7)."

Applicants respectfully question the accuracy of the assertions.

Further, Applicants respectfully traverse the assertion that WO '728 discloses a "cross-country ski system." Instead, WO '728 discloses an alpine ski system.

In claim 9, Applicants refer to at least one lateral shoulder of the ski for supporting the boot and, in claim 10, Applicants refer to lateral shoulders on respective lateral sides of the ski. On page 3, the Office action includes the assertion that WO '728 discloses these shoulders. Reference is made to the shoulders of WO '728 as elements 7', 7". On the contrary, elements 7', 7" are "cutouts" in the ski. Further, there is no evidence that a boot could/would be supported on shoulders of the WO '728.

The comments in the middle of page 4 of the Office action regarding Applicants' claim 14 appear to be in error. There reference is made that elements 42' and 42" are a "binding device" and that such "binding device" has a width less than the width of the ski.

On the contrary, as explained above, elements 42', 42" are merely plates upon which bindings are to be mounted. They are not bindings.

With alpine bindings mounted on a ski, the boot would not directly contact the upper surface of the ski directly.

In view of the foregoing, Applicants have not amended their claims, but request reconsideration and withdrawal of the rejection under 35 USC §102(b).

#### **D. New Claims**

New dependent claims 25 and 26 have been added.

Claim 25, depending from independent claim 13 specifies that "continuously, at each lengthwise increment along an entirety of the length of the binding zone, the upper surface of the ski has a width greater than a width of the binding device.

Claim 26, depending from claim 25, specifies that "with the binding device fixed to the ski in the binding zone, the lateral support surface is exposed for direct engagement of a lower surface of the boot during skiing."

The subject matter of claims 25 and 26 is not taught or suggested by WO '728 or HAUGHLIN, nor is it taught or suggested by a combination of WO '728 and HAUGHLIN, inasmuch as each of the documents would have an intermediate support plate between the boot and the ski.

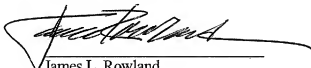
### CONCLUSION

The rejections advanced in the Office action have been addressed and are believed to be overcome. Reconsideration and allowance are respectfully requested in view of the amendment and remarks above.

Payment is being paid herein for a fee for a Request for Continued Examination and for extra claims. No additional fee is believed to be due at this time. However, the Commissioner is authorized to charge any fee required for acceptance of this reply as timely and/or complete to Deposit Account No. 19-0089.

Any comments or questions concerning this application can be directed to the undersigned at the telephone number, fax number, or e-mail address given below.

Respectfully submitted,  
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